

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Lal *et al.*

Application No. 09/763,397

Filed: February 16, 2001

For: RECOMBINANT MULTIVALENT MALARIAL
VACCINE AGAINST PLASMODIUM
FALCIPARUM

Examiner: V. Ford

Date: November 6, 2001

COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231



Art Unit: 1645

CERTIFICATE OF MAILING

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service on November 6, 2001 as First Class Mail in an envelope addressed to: COMMISSIONER FOR PATENTS, WASHINGTON, D.C. 20231

Tanya M. Harding, Ph.D.
Attorney for Applicant

RECEIVED

JAN 17 2002

TECH CENTER 1600/2000

ELECTION AND RESPONSE TO RESTRICTION

This is in response to the Office action dated October 9, 2001. A one month period for response was set, making a reply due by November 9, 2001.

Claims 1-12 of this §371 National Stage application were indicated as being subject to a restriction requirement. In particular, the Examiner designated claims 1-6 and 10 as Group I, claims 7-8 as Group II, claim 9 as Group III, claim 11 as Group IV, and claim 12 as Group V. Applicants respectfully traverse the restriction requirement. Applicants believe that Group I and Group II should be examined together, and therefore request reconsideration of the restriction requirement.

Groups I and II are linked to form a single general inventive concept. 37 C.F.R. § 1.475 requires unity of invention; unity of invention is present when a group of inventions are "so linked as to form a single general inventive concept." [See 37 C.F.R. § 1.475(a).] "A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature." [MPEP § 1893.03(d). See also 37 C.F.R. § 1.475(a).]

As an example of situation where unity of invention is present, the MPEP states, "For example, a corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the

claimed key." [See MPEP § 1893.03(d).] Thus, although a key and a lock are not the same, unity of invention between a key and a lock is present where certain characteristics of the key correspond to claimed features of the lock.

Similarly, unity of invention exists among Groups I and II in the present application. While claims 7 and 8 are directed to an isolated nucleic acid rather than a protein, the isolated nucleic acid of claim 7 (from which claim 8 depends) encodes the protein of claim 1. Thus, the single general inventive concept common to Groups I and II is the recombinant protein recited in claim 1. Moreover, the protein of claim 1 is neither disclosed nor rendered obvious by the prior art and thus constitutes a corresponding special technical feature, which is sufficient for the fulfillment of the unity of invention requirement. [See 37 C.F.R. § 1.475(a); MPEP § 1893.03(d).]

Applicants request that Groups I and II be examined together and that the requirement for restriction between Groups I and II be withdrawn. However, in the event the restriction requirement is maintained, Applicants provisionally elect Group I.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

By

Tanya M. Harding, Ph.D.
Registration No. 42,630

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 226-7391
Facsimile: (503) 228-9446